

15 MAR 2007



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In re Application of :  
Phelps et al. :  
Application No.: 10/520,056 :  
PCT No.: PCT/GB03/02848 :  
Int. Filing Date: 03 July 2003 :  
Priority Date: 03 July 2002 :  
Attorney Docket No.: 04270/0202280-US0 :  
For: Nuclear Hormone Receptor :

COMMUNICATION

This is in response to the "Renewed Request For Refund" filed on 27 January 2006.

#### BACKGROUND

This international application was filed on 03 July 2003, claimed a priority date of 03 July 2002, and designated the United States. The International Bureau transmitted a copy of the published international application to the USPTO on 15 January 2004. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 03 January 2005. On 29 December 2004, applicants filed *inter alia* the basic national fee.

On 01 September 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h), as well as an initial computer-readable form (CRF) of the Sequence Listing, and a statement that the contents of the CRF and the written (paper or compact disc) sequence listing are the same and, where applicable, contain no new matter.

On 03 October 2005, applicants filed a "Request For Refund..."

On 30 December 2005, a communication was mailed to applicants, indicating that "Your refund request for 10520056 in the amount of \$2,610.00 has been denied. Authorization was given to charge any additional fees in the Transmittal Letter."

On 23 February 2007, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants, indicating that this international application had become abandoned with respect to the U.S. national stage for failure to timely reply to the Notification of Missing Requirements mailed on 01 September 2005.

#### DISCUSSION

Counsel states that

The U.S. Patent and Trademark Office (the "PTO") erred when it charged Applicants the Examination, Search, Excess Claim of two separate charges, Multiple Dependent Claim, and Application Size Fees for this application. Payment of those fees was not authorized. Those fees, which total \$2,610.00, should therefore be refunded to Deposit Account No. 04-0100 of the undersigned attorneys/agents

and argues that

the 371 Transmittal submitted with this application (Tab A) only authorized the Commissioner of Patents to Charge any additional fees that may be required - i.e., fees whose payments were required to effect entry into the national stage and avoid abandonment of this application... The Examination, Search, separately charged Excess Claim, Multiple Dependent Claim, and Application Size Fees charged for this application were not required, neither to begin national phase entry nor to avoid abandonment of this application. Hence, the payment of these fees was not authorized and they should be refunded.

Review of the record reveals that the Transmittal Letter filed on 29 December 2004 itemized a check in the amount of \$300.00, and that the fee calculation appearing on the same sheet stated that "The following fees are submitted: Basic national fee \$300." The same sheet of the Transmittal Letter also included a general fee authorization: "The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 04-0100." Counsel's suggestion that this authorization did not cover the fees charged is not persuasive. The fact that the Examination, Search, Excess Claim, Multiple Dependent Claim, and Application Size Fees are not specifically required to be paid to avoid abandonment under 35 U.S.C. 371(d) does not mean that those fees are optional, or "not required." Moreover, the record shows that petitioner separately paid the basic national fee by check. If applicants considered that the basic national fee was a "required" fee while the other fees due in this case were not "required," what was the purpose of ambiguously authorizing "any additional fees which may be required" to be charged to the Deposit Account, rather than providing a clearly limited scope of authorization - e.g., --? the USPTO is hereby authorized to charge the basic national fee... --? Counsel's attention is directed to MPEP 509.01, which explains in part that

Many applications contain broad language authorizing any additional fees which might have been due to be charged to a deposit account. The U.S. Patent and Trademark Office will interpret such broad authorizations to include authorization to charge to a deposit account fees set forth in 37 CFR 1.16, and 1.17...

It is extremely important that the authorization be clear and unambiguous. If applicants file authorizations which are ambiguous and deviate from the usual forms of authorizations, the Office may not interpret the authorizations in the manner applicants intend and may return the fees. As a result, applicants could be subject to further expenses, petitions, etc...

37 CFR 1.25(b) further provides that an authorization to charge fees under 37 CFR 1.16 (which relates to national application filing fees) in an application filed under 35 U.S.C. 371 will be treated as an authorization to charge fees under 37 CFR 1.492 (which relates to national stage fees).

Following the policy explained at MPEP 509.01, the broad fee authorization included in the Transmittal Letter was properly interpreted as authorizing the fees under 37 CFR 1.492 to be charged to the indicated deposit account. If counsel intended an interpretation of the fee authorization deviating from the usual interpretation given such broad authorizations, a clear statement of the scope of the fee authorization should have been provided at the time the authorization was made. 37 CFR 1.26(a) states in part that

The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

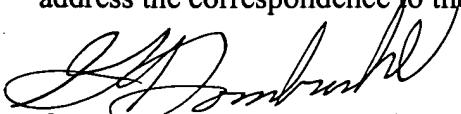
In the instant case, the fees charged were payable in this application at the time the Transmittal Letter was filed, and so were not mistaken nor in excess of that required. A change of purpose after the payment of the fees is not sufficient cause to entitle applicants to a refund under 37 CFR 1.26(a). For all of these reasons, it would not be appropriate to grant the requested refund on the basis of the present record.

**CONCLUSION**

The refund request is **DISMISSED**, without prejudice.

Any request for reconsideration of this matter must be filed within **TWO (2) MONTHS** of the mailing date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the correspondence to the attention of the Office of PCT Legal Administration.



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